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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,617	02/12/2002	Shang Ren Henry Kao	9661-027	7952

7590 04/27/2004

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EXAMINER	
NASSER, ROBERT L	
ART UNIT	**PAPER NUMBER**
3736	

DATE MAILED: 04/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/074,617	KAO ET AL.	
	Examiner	Art Unit	
	Robert L. Nasser	3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 February 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4, 6, 7, 9-30* is/are rejected.

7)☐ Claim(s) *5 and 8* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 10-25, 28, and 29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6375622. Although the conflicting claims are not identical, they are not patentably distinct from each other because system claims of 20-25 and 28-29 of the patent are merely broader versions of the patented claims, and, as such, are covered by the patented claims. In addition, with respect to claim 10, it would have been obvious to use the device of the patent to monitor a handwriting activity. The exact handwriting activity would have been obvious to one skilled in the art.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10, 11, 13, 14, 16, 17, 20-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Fleischaker. Fleischaker shows a method for treating a heath

condition of a user including determining a sensory signal, skin temperature (see column 2, lines 58-65) of a user while the user is writing and using the sensory signal to feedback to the user to induce a looser grip, which treats the medical condition. The examiner notes that handwriting is copying an graphic element. The signal is indicated by a color change of the sensor. The examiner notes that writing is consider to be" composing a graphic production."

Claims 20, 21, 22, 23, 25, 29, and 30 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Reuss et al. Reuss shows a system including a plurality personal care devices each with a plurality of sensors that are used to treat a medical condition.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4, 6, 7, 9, 12, 15, 18, 19, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fleischaker. The only feature lacking of Fleischaker is the step of providing the graphic element. Fleischaker states it is used for writing, but it does not state whether the thing to be written is provided to the user. The examiner notes that Fleischaker is intended to prevent further injury during all writing including drawing, tracing, and copying. As such, it would have been obvious to use the device of Fleischaker when drawing or copying or tracing as well as freehand writing, to prevent

injury to the user. The examiner further notes that copying or tracing involve providing a graphic element.

Claims 5 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 5 defines over the art in that none of the art shows an eeg device in combination with a graphic design element (brush, pen, pencil etc) as claimed.

Claim 8 defines over the art of record in that none of the art has the method including a graphic design element and 2 sensors, as claimed.

Applicant's arguments filed 2/19/2004 have been fully considered but they are not persuasive.

Applicant has asserted that Fleischaker does not treat a medical condition. The examiner disagrees. The claim states that the sensory signal is used to regulate a user's behavior, thereby treating a condition. In Fleischaker, the medical condition is potential hand damage. The sensory signal indicates that too much grip pressure is applied and the hand is in danger of damage. The signal is used to alert the user to lessen the grip pressure, i.e. regulates the behavior, which thereby treats the condition. Therefore, it is the examiner's position that Fleischaker treats a medical condition. The examiner notes that the terms "treat" and "medical condition" are quite broad and are met by Fleischaker, as discussed above.

Applicant further asserted that Reuss does not regulate a user's activity. The examiner notes that claim 20 is an apparatus claim. The limitation in question states

that the changes in the sensory signal are used to . . . . . This is clearly a statement of intended use and the Federal Circuit has made clear that such limitations are not suitable to define over a device with the identical recited structure. Reuss has all the structure recited in the claim. Therefore, it anticipates the claim.

Applicant has asserted that Fleischaker foes not use the change of the sensory signal to regulate the user's activity. It is the examiner's position that Fleischaker is quite clear in column 2, lines 67-column 3, line 6, that the change in the sensory signal is used to alert the user to use less grip pressure, thereby regulating behavior.

Applicant has further argued that Fleischaker does not disclose the graphic elements recited in the claims, specifically claims 7 and 27. The examiner disagrees. Fleischaker necessarily has applications for the user for all writing, to prevent injury. As such, it applies during tracing or copying. If one were to a copy something written, then there is necessarily a template with letters or characters or numbers. Hence, it is the examiner's position that Fleischaker meets the claim limitations.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert L. Nasser whose telephone number is (703) 308-3251. The examiner can normally be reached on Mon-Fri, variable hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (703) 308-3130. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert L. Nasser
Primary Examiner
Art Unit 3736

RLN
April 23, 2004

ROBERT L. NASSER
PRIMARY EXAMINER